

REMARKS:

REMARKS REGARDING CLAIM AMENDMENTS:

The Office Action indicated objection to claims 16, 21 and 22. The affected claims have been amended to overcome the objection and are believed to be in condition for allowance. Support for amendment of claim 16 exists in paragraphs [0016], [0041] and [0048] and Figure 4 of the present application. Paragraph [0046] provides support for amendment of claim 22.

Applicants request reconsideration and withdrawal of objection to claims 16, 21 and 22.

Claims 1 – 22 are pending in the present application.

IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 103(a):

The Office Action indicates rejection of claims 1, 3, 6 – 10 and 14 – 22 as being unpatentable under 35 U.S.C. 103(a) over US 5,445,630 to Richmond in view of US 5,766,211 to Wood.

In response to the Office Action applicants have considered the Examiner's reliance on the combination of references of Richmond (U.S. 5,554,630) in view of Wood (U.S. 5,766,211) but respectfully disagree that this combination meets the teaching requirements for rejection of claims of the present invention for obviousness under 35 U.S.C. §103.

Applicants will provide evidence to show that Richmond in view of Wood does not provide a *prima facie* case of obviousness. The following table summarizes the evidence by concisely identifying differences between the present invention and teachings of the references of Richmond and Wood as follows:

Comparison of the present invention and the references (Richmond in view of Wood)

| Claims Requirements of the Present Invention | Richmond U.S. 5,445,630 and Wood U.S. 5,776,211 |
|---|--|
| Claim 1 recites “at least a first portion made of a first material and a second portion made of a second material” | As admitted by the Office Action, Richmond fails to teach a first portion of a first material and a second portion of a second material. Wood teaches (Col. 6, lines 36 – 45) that elastic material is part of the injection port (See Fig. 1) thereby teaching away from the present invention. |
| Claim 1 recites “said first and second portions are attached to each other by means of a combined friction coupling and snap connection providing a first retention force.” | The reference does not teach a first portion, a second portion or a friction coupling including a snap connection for retaining the first portion in attachment with the second portion (see discussion below). |

Regarding the contents of a 35 U.S.C. §103 rejection, MPEP 706.02(j) includes the following statement:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." (emphasis added)
Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

Regarding the need that, “the references must expressly or impliedly suggest the claimed invention,” the summary table shows at least two ways in which Richmond and Wood are either silent concerning limitations of claim 1 of the present invention or, as in the case of Wood, teach away from the present invention (see claims 8 and 9 of the present invention). Considering the Office Action’s statement of rejection, there appears to be evidence of impermissible hindsight. According to MPEP 2142 (Legal Concept of *Prima Facie* Obviousness), impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

In the rejection of claims 1 and 9 of the present invention, the Examiner asserts, “Richmond illustrates that the portions are separate through the use of diagonal lines, indicating that the portions may be made of different materials.” This refers to a portion of Figure 6 of Richmond. Applicants detect two problems with this assertion. The first is the fact that it is conventional to use diagonal line shading to represent metallic structures, i.e. the parts illustrated by Richmond could be made of the same metal. Secondly, an illustration is ineffective for conveying what Richmond intends to represent. For this purpose it is necessary to consult the descriptive portion of the disclosure.

Although the Examiner relies upon Figure 6 of the reference, there are no identifying numerals for the portions asserted to be separate. Clarification of the portions can be found by reference to Figures 1 and 2 and Column 4, lines 23 – 32 stating, “first flange 40 closely surrounds a second cylindrical flange 42 that is part of the luer fitting 22 shown in FIGS. 1 and 2. The first and second flanges 40, 42 are bonded together by means well-known in the art, e.g., solvent bonding, rf sealing, heat staking, or sonic welding.”(emphasis added).

Not only are the portions likely constructed from the same material but Richmond teaches the need for bonding together of the two portions. This teaches away from the present invention according to paragraphs [0029] and [0045] in the instant application.

Another statement regarding the “type of connection between the first and second portions,” further suggests the influence of impermissible hindsight. The specific statement asserts:

“It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. In the instant case, applicant has failed to set forth any structural limitations that define the claimed connection. The Richmond device appears to have a friction fit between the first and second portions, which may snap into place. Absent any defining structural characteristics, the Richmond device is capable of operating as claimed by applicant, meeting the limitations of the claim.” (emphasis added).

Applicants respectfully disagree to failing to set forth structural limitations that define the claimed connection. As shown in the summary table, “said first and second portions are attached to each other by means of a combined friction coupling and snap connection providing a first

retention force.” This recitation of claim 1 addresses the two structural components of a friction coupling and a snap connection.

Richmond clearly teaches, at Column 4, lines 23 – 32, that the portions identified by the Examiner are bonded together. A bonded connection does not provide releasable connection expected of a friction fit connection. Any implication of such a friction fit connection resides in knowledge of the present invention, but is not taught by Richmond.

It appears that the Office Action attributes properties to the structure of Figure 6 of Richmond that are not supported by the specification thereof. This is contrary to the requirement of MPEP 706.02(j) that, “the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention - - .” Evidence of failure to provide a “convincing line of reasoning” is found in the tenuous statement, “It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations. See MPEP 2114.” Previous discussion shows that Richmond fails to teach the claimed structural limitations of a friction coupling and a snap connection as recited by claim 1 of the present invention. This indicates that MPEP 2114 is not applicable to claim 1 of the present invention.

The Office Action correctly states that, “Richmond is silent with regard to the materials used to construct the second part of the connector.” Wood (U.S. 5,766,211) is used to supply the necessary teachings. The cited portion of Wood includes description of a medical fluid mixing connector that comprises a rigid housing 12 and connecting cylinders 25, 5 and 6 made of an elastic material such as rubber (see Wood column 6, lines 36 – 45). The description makes reference to Figure 1 of Wood. Review of Figure 1 clarifies that the description relates to an injection port corresponding to the first portion recited in claim 1 of the present invention, which first portion is the less resilient or more rigid portion. Wood suggests that the first portion is the more resilient, thereby teaching away from the present invention.

The evidence shows that Richmond in view of Wood fails to either teach or suggest all the limitations of the present invention as required for rejection of claims for obviousness under 35 U.S.C. §103. Further, the evidence suggests that the rejection is based upon impermissible hindsight and aspects of the teachings of both Richmond and Wood teach away from the present

invention. Contrary to the requirement of MPEP 706.02(j), it does not appear that rejection of claims of the present invention is based upon facts gleaned from the references.

The previous discussion shows that Richmond in view of Wood is ineffective as a basis for rejection of claim 1 of the present invention for obviousness. Applicants believe that claim 1 should be allowed. Remaining claims 2 – 22 all depend from claim 1 and should likewise be allowed.

In view of the above, applicants submit that the requirement and burden of presenting of a *prima facie* case of obviousness under 35 USC §103 has not been met. Therefore applicants request reconsideration and withdrawal of the rejection of claims 1, 3 and 6 - 22 under 35 USC §103(a).

ALLOWABLE SUBJECT MATTER

Applicants appreciate notification of allowable subject matter associated with claims 2, 4, and 5. Claims 1 – 22 as presented above are believed to be allowable. For this reason amendment of claims 2, 4, and 5, as suggested by the Examiner, is postponed until further examination of the pending claims on the merits.

CONCLUSION

The prior art made of record and not relied upon has been considered. The reference of Utterberg (US 5,071,413) does not appear to be pertinent to the present invention as currently claimed.

Applicants have made an earnest attempt to provide a response applicable to all the points included in the Office Action and, in view of the above, submit that the requirement and burden of presenting of a *prima facie* case of obviousness under 35 USC §103 have not been fulfilled. Amendment of claims places the application in condition for allowance. Consequently, request is respectfully made for reconsideration of the application and notification of allowance of claims 1 - 22 in the next paper from the Office.

The undersigned representative requests any extension of time that may be deemed necessary to further the prosecution of this application.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Attorney Docket No.: 06730.0020.NPUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner may directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Tracy W. Druce".

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